

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Title: Inert Tactical Weapon System and	)	
Method of Use	)	
	)	
Inventor: Ham, Jerry	)	
	)	On Appeal
Serial No. 10/738417	)	
	)	
Filing Date: Dec. 17, 2003	)	

Commissioner for Patents  
 P. O. Box 1450  
 Alexandria, VA 22313-1450

**Response to Second Notification of Non-Compliant Appeal Brief**

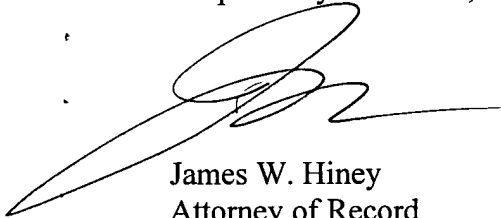
Filed herewith is the 2<sup>nd</sup> amended brief on the above mentioned case including a change to the recitation on section II and an addition of sections IX and X as noted by the Center Specialist. While the Applicant does not see any difference in the former recitation of Section II it has been changed to say the same thing. The Section IX has been noted as "none". A copy of the Non-Compliant Notice is enclosed.

It should be noted that the Specialist is incorrect in stating that there are no citations provided in the case as these were provided in a response dated Oct. 7, 2007 and will be in the complete file held by the Examiner.

Both amended and clean versions of the claims were submitted with the last response. If the amended versions are not acceptable then the Office should dispose of them and disregard them as there are clean versions in the file.

Hopefully this is the end of what has been an lengthy delay process in attempting to have the Examiner respond to applicants brief. Such an Answer is urgently requested in a timely fashion as much time has been wasted on this application due to questionable formalities.

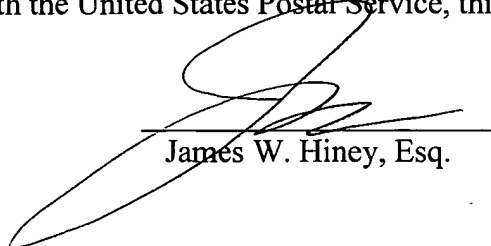
Respectfully submitted,



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#### **Certification of Mailing**

I, James W. Hiney, do hereby certify that an executed copy of this letter of transmittal, a copy of the prior letter of transmittal of legal citations and an amended copy of the appeal brief were deposited, Express Mail Postage No. EB 402163943 US, prepaid, with the United States Postal Service, this 18<sup>th</sup> day of March, 2008

  
James W. Hiney, Esq.



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of Jerry Ham

Serial No. 10/738,417,

Filed Dec. 17, 2003

Title: **Inert Tactical Weapon System and Method of Use**

**SECOND AMENDMENT TO APPEAL BRIEF**

**I. REAL PARTY IN INTEREST.** The real party in interest in this appeal and application is Jerry Ham who is the sole inventor and sole owner of the rights to the invention. There has been no assignment of any rights.

**II. RELATED APPEALS OR INTERFERENCES.** None.

**III. STATUS OF CLAIMS**

Claims 1 – 20 were filed with the case. As a result of a restriction requirement and response with traverse, claims 1 – 9 stand withdrawn from consideration and claim 20 was cancelled

The claims under appeal are claims 10 through 19 which are submitted herewith, again, in Appendix VIII, which was filed with the original brief. An added copy, showing the last amendments to the claims, is also filed with Appendix VIII.

**IV. AMENDMENTS .** There are no amendments to the claims pending and they have been amended only once since the filing of the application. To restate, there are no pending amendments to the claims currently in the application.

#### **V. SUMMARY OF CLAIMED SUBJECT MATTER**

The claims can be summarized as follows:

The claims call for a CO<sub>2</sub> neutralizing system for use against terrorists and the like where the terrorists have hostages in a confined space and therefore the use of guns and conventional weapons is precluded due to the presence of the hostages.

Claim 10, the independent claim upon which all the remaining claims are based, calls for a source of CO<sub>2</sub>, a means to create an opening into the confined space and a means to deliver the CO<sub>2</sub> into the space, the means to create an opening and the means to deliver CO<sub>2</sub> being operatively connected. The means plus function are a combination of the lance 20 and the battering ram 21 shown in Figures 1 –3 and mentioned in the last

paragraph of Page 8.

Claim 11, dependant upon claim 10, defines the CO<sub>2</sub> source as a tank 11 with a delivery hose 13 shown in Figure 1. . Claim 17, dependant on claim 11, which recites that the two means are one in the same member. I.e. the lance and battering ram constitute the means to create an opening and deliver gas are the lance 17 and battering ram 21.. Claim 18, dependant upon claim 17, recites that one portion of it is a lance, 17 shown in Figure 1, and the other a battering ram 21, mentioned on page 8 of the specification.. Claim 19, dependant upon claim 18, adds the limitation that the member has an adjustment valve 12 ( page 8, last paragraph ) for regulating the gas.

Claim 12 , dependant upon claim 10, defines the means to create an opening as a battering ram 21 shown in figures 2 and 3 and mentioned on pages 8, last paragraph and on page 9, first paragraph.

Claim 13 , dependant on claim 10, calls for the delivery means to comprise a hollow lance 17 and connected to the battering ram 21 at the forward end thereof. Claim 14, dependant on claim 13, adds the limitation of the lance having a valve means, 12 as seen in Figure1- 4. to control the gas. Claim 15, dependant on claim 14, adds the limitation of the lance having dissipation holes 35 to disperse the gas into the confined space.

Claim 16, dependant on claim 10, adds the limitation that the gas has an odorant mixed therein so as to create a false impression of the nature of the gas. Claim 17 recites the combination of the lance and battering ram 21.

Claim 19 calls for an adjustment valve, 12, as shown in Figure 1.

**VI. REJECTIONS** The claims have been rejected as anticipated by McClenahan and Coughlin and as obvious over Roberts in view of either Medlock or Coughlin. This is an interesting scenario the Examiner has formulated which, as will be pointed out, is replete with contradictions.

**(i) Claims 10 – 15 and 17 – 19 are rejected under 35 USC 103 as unpatentable over Roberts ( '753 ) in view of either Medlock ( 005 ) or Coughlin ( 417 ).**

Roberts discloses a fire fighting device which is used to punch a hole in a wall to inject a fog or mist for dousing the fire. It employs a nozzle 10 having orifices such as 38 which allow the chemical to flow through the wall via the nozzle and disperse into the room space. A ram 12 is used to drive the nozzle through the wall. The invention appears to be, with reference to the claims, the angles and arrangement of the orifices in the nozzle.

Medlock shows a device for fighting fires in aircraft fuselages while the aircraft is on the ground. The device employs a nozzle 36 which, at the end of a long truck mounted boom, penetrates the skin of the fuselage when the truck runs the boom ( and nozzle ) into the side of the aircraft. There is no ram, per se. The device uses CO2 to flow down the boom and into the aircraft fuselage through the nozzle.

Coughlin discloses a base for a fire fighting device on a ship where a ram is used to drive a nozzle through the steel of a bulkhead on the ship. The nozzle can have orifices

through which CO2 or another firefighting agent can be dispersed into the ship.

**(ii) Claim 10 – 19 are also rejected as being anticipated by McClenahan under 35 USC 102(b).**

McClenahan discloses a barrier penetrator for firefighters. The device has a slide hammer to penetrate a wall with a nozzle having ports 51 through which a fire fighting agent flows into the confined space penetrated by the slide nozzle. The invention appears to be a very detailed and limited configuration as evidenced by claim 1 thereof. McClenahan shows a penetrator having an impact barrel with a central axis, an internal guide wall, an axially extending nozzle in said impact barrel, having an axially extending passage, with nozzle ports, a point and shoulder on said nozzle, a slide rod in an end cap and a collar on said rod, a slide hammer slideable mounted on said rod, retention means, and an inlet port means. The Examiner states that in lines 12 through 22 of column 1 there is mention of an odorant.

Claim 16 calls for an odorant to disguise the smell of the CO2 and the Examiner states that such odorant is shown in McClenahan.

**(iii). Claims 10 – 15 and 17- 19 are also rejected as anticipated by Coughlin under 35 USC 102 (b).**

Coughlin discloses a “base for a fire-fighting tool”. While there are several embodiments shown, the basic invention is a deck mounted member ( see Claim 1 ) which connects with a support leg of a firefighting tool which is ram operated and entails

a nozzle 19 having an angled surface adapted to penetrate a bulkhead or the like on a ship. An extendible ram 23 has air injected therein to force the nozzle through a bulkhead. Once the bulkhead is penetrated liquid to fight fire is forced into the space through orifices 51. The invention is basically designed to work on steel walls as one would find in a ship. While the use of CO2 is mentioned in line 4 of column 2 it is in reference to a prior patent, U. S. No. 2,732, 017, which is used to extinguish burning tires and in column 23, line 8 where it is mentioned as a means to fight a fire.

## **VII. ARGUMENTS ATTACKING REJECTIONS**

### **Rejection of claims 10 – 15 and 17 – 19 under 35 USC 103 over Roberts in view of either Coughlin or Medlock.**

(i) The rejection of claims 10 – 15 and 17 – 19 as unpatentable over Roberts in view of either Coughlin or Medlock is ill taken and does not stand up to scrutiny. The initial problem is with the basic reference Roberts, which is not an anti-terror device but merely a mechanism for suppressing fire. There is simply no teaching of using the device for dealing with terrorists who have captives. Nor would there be any reason for modifying Roberts to use CO2. For what reason? Where is the problem that Roberts is solving that would be solved by using CO2. The Examiner merely suggests that it would be obvious to substitute one fire suppressant for another and relies on either secondary reference to do so. What he does not state is that there is no teaching of a reason to do this. What hostage situation is the Examiner responding to by applying



Roberts who says nothing about terrorists and hostages. There simply is no teaching reference. Why would you change suppressants in Roberts? Roberts states, line 4 of column 1 that he is using a spray, mist or fog. None of that sounds like CO2 so there is no reason to make the substitution. Neither do Coughlin or Medlock describe neutralizing terrorist in a hostage situation. The Examiner makes the substitution for another reason having nothing to do with this invention. Just because CO2 is described as a fire suppressant is not sufficient to make the mental jump to substituting it or even using it for a terrorist neutralization.

The standard imposed by 35 USC 103 is that the differences between the subject matter sought to be patented and the prior art are such that “ the subject matter as a whole would have been obvious .....to a person having ordinary skill in the art to which the subject matter pertains.” ( emphasis added ). In the instant case, the subject matter to which this invention applies is the submission of terrorists in a hostage situation, not how to put out a fire in a building. Here, the subject matter is totally different from the applied prior art. Roberts has no teaching of using a penetrator-ram to gain access to a confined space in which terrorists are holding hostages. He is merely concerned with putting out a fire.

A reference must be considered in its entirety and Roberts is not directed to a device or system for neutralizing terrorists. The Examiner cannot pick and chose those parts of a reference which fits his argument See In re Fracalossi, 681 F2d 792, 794 215, USPQ 569 (CCPA 1982 ) The Board of Patent Appeals and Interferences has cautioned against focusing on the obviousness of the differences between the prior art

and the claimed subject matter rather than on the obviousness of the invention as a whole as §103 requires. See Hybritech Inc. v. Monoclonal Antibodies, Inc. 802 F.2d 1367, 1383, 231 USPQ 81, 93 ( Fed. Cir. 1986 ) There must be a basis in the art for combining or modifying references. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, *absent some teaching, suggestions, or incentive supporting the combination.* ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) The Examiner merely suggests that it would be obvious to substitute one fire suppressant for another and relies on either of the secondary references to do so. What the Examiner does not state, however, is that there is no teaching of a reason to do this.

#### **Claims 10 – 19 rejection under 35 USC 10 over McClenahan**

(ii) The rejection of claims 10 – 19 as anticipated by McClenahan is unsustainable. Right off the bat the Examiner states that the odorant is shown by McClenahan. Not so! For what purpose would an odorant be used in a fire suppressant system? In the instant invention the odorant is to mask the smell of the CO<sub>2</sub> so as not to “tip off” the terrorists as to the true nature of what gas is being introduced. There is not mention of an odorant in lines 12 through 22 of column 1 as stated by the Examiner. The only function of the slide in McClenahan is to penetrate the thin aluminum outer skin of the fuselage and not much weight is required. It is not akin to penetrating a door or wall in a hostage situation. In addition, in a hostage situation one cannot just “pour” into huge quantities of CO<sub>2</sub> as it must be carefully monitored based on the size of the space. The amount is

designed to make the occupants of the space groggy and not cognizant of their situation but not to kill them which uncontrolled amounts of gas would do. Once the occupants are groggy a hostage rescue team can evacuate the hostages and other law enforcement can secure the terrorists. The first priority are the hostages, not the terrorists.

The proscription of 35 USC 102 (b) is that the subject matter is not patentable if the invention was “patented or described in a printed publication” more than one year before the application under consideration. Here, the invention was not patented or described in a printed publication. The McClenahan reference is not an invention for dealing with terrorists by introducing CO2 into a space where they are holding hostages. It deals only with putting out fires. One cannot modify McClenahan without some basis in the art for combining or so modifying his teaching. Nor is there any mention in that prior art of an “odorant” as in claim 16. Likewise, the adjustment valve recited in claims 14 and 19 is to regulate the amount of CO2 so as not to kill the occupants of a building. Nowhere in McClenahan is it disclosed that such a valve is used to adjust the amount of CO2 in particular.

A claim defines the metes and bounds of the rights which applicants seek to cover. Claim 10 calls for “ A CO2 neutralizing system for use against terrorists and/or hostage takers within a confined space.” The Examiner is not interpreting the correct metes and bounds which applicant requests in the claims. In re Vamco Machine & Tool Co., Inc, 752 F2d 1564, 1577 , 224 USPQ 617, 625, ( Fed. Cir. 1985 )

**Rejection of Claims 10 – 15 and 17 – 19 under 35 USC 102 over Coughlin**

(iii) Nowhere in the Coughlin patent, which is used to reject claims 10 – 15 and 17 – 19 as anticipated by its disclosure, does he mention the use of a device to combat terrorism. Obviously, in such a situation one would not want to have a fire in the space and the use of CO2 has to be very carefully monitored unlike in a situation only involving a fire. There is no need in the latter case to monitor the amount or density of the gas. In essence the problems that the instant invention seeks to redress are totally different from that of the reference.

Again, the reference does not show that the “invention was patented or described in a printed publication” more than one year before this application was filed. The invention here is a system for dealing with terrorists, not a fire treatment system. For a rejection to be sustained under 35 USC 102(b) the prior art must *identically disclose* the claimed invention. Nor does Coughlin concern himself with regulating the amount of CO2 so as not to kill the occupants of the building. Nor does he mention anywhere the use of an odorant to disguise the CO2 to occupant terrorists who might kill the hostages or commit some other act if they realized they were being subjected to CO2. Coughlin merely is concerned with fighting fires, nothing else. This rejection is really a 103 rejection without a base teaching reference....it is not a 102(b) rejection

Nowhere in the Coughlin patent does he mention the use of a device to combat terrorism where the terrorists have hostages.

## **VII. Conclusion**

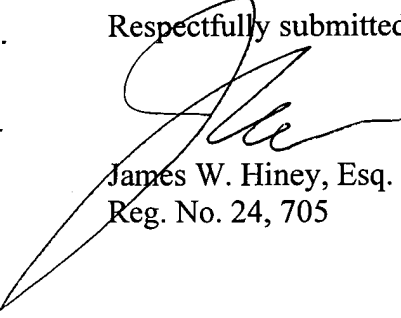
For all the foregoing reasons it is believed that the three rejections of the claims, two based on 35 USC 102(b) and one on 35 USC 103 should be reversed and allowance of claims 10 through 19 is respectfully requested.

**VIII. The claims on appeal, 10 – 19, are attached as appendix VIII.**

**IX.** None.

**X.** The copies of the decisions relied upon by Applicant in this brief have already been submitted with the first brief, and again submitted in response to the notice of incomplete brief mailed to the Applicants attorney of record.

Respectfully submitted,



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March 18, 2008



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Title: Inert Tactical Weapons System and Method of Use )  
Inventor: Ham, J ) On Appeal  
Serial No.: 10/738417 )  
Filing Date: Dec. 17, 2003 )

Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

**Response to Notification of Non-Compliant Appeal Brief**

Enclosed please find a copy of the cited art and the legal citations noted in the appeal brief which was filed in September, 2006. The art of record and the legal cites were filed with the brief but the mail room evidently lost the attachments. A copy of the Notification is filed herewith and it is noted that it took months for the Office to issue this Notification.

A review of the Appeal brief itself notes that there is not problem with it. The art of record was entered into the case with the second rejection. The two documents groups are listed as appendices hereto. It is assumed that the Examiner can ascertain what reference is what in his reply brief or does the office now require spoon-feeding of

Examiners? The discussion of the references appears on pages 3 through 7 of the brief.

The appendices are noted as Appendix IX for the prior art relied upon by the Examiner and Appendix X is the list of legal citations in the Appeal Brief.

Also attached is a Request for a two month Extension of Time with an accompanying check for a small entity.

Should there be any other issue before the Office it is requested to call the undersigned attorney of record so more time will not be wasted in the prosecution of this application.

Respectfully submitted,

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#### **Certification of Mailing**

I, James W. Hiney, do hereby certify that an executed copy of this response was deposited, Express Mail Postage No. EB 314291765 US, prepaid, this 12<sup>th</sup> day of October, 2007 addressed to Commissioner for Patents, Board of Appeals, P. O. Box 1450, Alexandria, VA 22313-1450.

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James W. Hiney

**Notification of Non-Compliant Appeal Brief  
(37 CFR 41.37)**

MAR 19 2008

Application No.

10/738,417

Applicant(s)

HAM, JERRY D.

Examiner

S. Johnson

Art Unit

3641


--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 02/27/2008 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer.  
**EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☐ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☐ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☐ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☐ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☒ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner **and relied upon by appellant in the appeal**, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☒ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☐ Other (including any explanation in support of the above items):

Sections IX and X. The evidence appendix and related proceedings appendix are missing from the brief. If there is no evidence or related proceedings appendix, then the indication of "none" should be present after both headings. Section VIII only the clean version of the claims are acceptable the marked up claims are not needed.

  
LASHAWN HINTON  
PATENT APPEAL CENTER SPECIALIST